

a three-dimensional, top stop in the form of a figure having an upper torso supporting a head and a pair of forelimbs;

a three-dimensional, bottom stop in the form of a complementary portion of said top stop and including a retention member for retaining a coiled portion of said connector; and

wherein said stops inhibit the removal of the bookmark in a direction substantially parallel to the length of the spine when the bookmark is inserted between pages of the book.

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31. (New) A bookmark as set forth in claim 30 wherein:

said stops cooperate when said connector is coiled around said bottom stop to form a sitting figure.

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REMARKS

Applicant gratefully acknowledges the indication of clerical inconsistencies in the drawings and the specification pointed out by the Examiner. The applicant has made minor corrections to the drawings and to this end provides a Letter to the Official Draftsman correcting the drawings. More specifically, in FIG. 3 reference designation "38" has been changed to "37" and in FIG. 12, one of the reference designations "54" has been changed to "55". The inconsistencies pointed out by the Examiner in the specification have also been corrected.

In addition to the Letter to the Official Draftsman, enclosed is a petition and fee for a three month extension of time for responding to the March 23, 1999 Office Action.

The Examiner has initially rejected claims 6, and 8-15 for failing to provide an antecedent basis for some terms in these claims. Applicant has canceled these claims and substituted new claims 16-31 therefor. Antecedent basis has been provided in the new claims.

The Examiner has also rejected claims 1-4, 6-10, 12 and 13 as being unpatentable over Crane. Claims 5 and 11 have been rejected as being unpatentable over Crane in view of Clare. Claim 14 has been rejected as being unpatentable over Crane in light of Cox. The Examiner has also rejected claim 15 as being unpatentable over Crane and Cox in further view of Clare. These claims have been canceled and new claims 16-31 have been substituted therefor. It is believed that the new claims are in condition for allowance.

REJECTION UNDER 35 U.S.C. §112

The Examiner has initially rejected claims 6, and 8-15 for failing to provide an antecedent basis for some terms in these claims. Applicant has canceled these claims and substituted therefor claims 16-31. The antecedents in these claims have been reviewed and it is believed that the required antecedent basis has been provided. This rejection should therefore be removed.

REJECTION UNDER 35 U.S.C. §103(a)

Claims 1-4, 6-10, 12 and 13 stand rejected as being unpatentable over Crane. Claims 5 and 11 have been rejected as being unpatentable over Crane in view of Clare. Claim 14 has been rejected as being unpatentable over Crane in light of Cox. The Examiner has also rejected claim 15 as being unpatentable over Crane and Cox in further view of Clare. These claims have been

canceled and new claims 16-31 have been substituted therefor. It is believed that independent claim 16 recites a combination of features that are not shown or suggested by the references of record. More specifically, claim 16 is directed to a bookmark and recites:

a flexible, elongated, intermediate member having a first end and an opposing second end, said member having a predetermined length and being sufficiently thin to extend between the pages of the book and along the length of the spine of the book without stretching its binding;

a top anchor having a thickness in a direction substantially perpendicular to the length of the spine and being in the form of a first portion of a character including a head and secured to said first end;

a bottom anchor having a thickness in a direction substantially perpendicular to the length of the spine and being in the form of a second portion of said character complementing said first portion and secured to said second end;

wherein the length of said intermediate member may be extended from its predetermined length to accommodate books of different sizes; and

wherein said anchors inhibit removal of the bookmark in a direction parallel to the length of the spine when the book is closed and the bookmark inserted therein.

None of the art relied on by the Examiner shows or suggests a flexible intermediate member that can extend its length and includes complementary anchors at both ends to inhibit

removal of the bookmark in a direction parallel to the length to the spine. This structure is advantageous because it accommodates different sized books and is particularly useful to keep young kids from inadvertently removing the bookmark and thus losing their page.

The Examiner's primary reference, U.S. Patent No. D66,322 to Crane, merely displays an intermediate member having a loop and a human character's head attached to one end of the intermediate member and a pair of leg members attached to the opposing end. The length of the intermediate member does not appear to be adjustable to accommodate different sized books and the two ornamental members lack sufficient thickness to prevent the bookmark from being withdrawn in a direction parallel to the length of the spine. In other words the two-dimensional ornamental features as taught by Crane are not structured to provide a stop or anchor function. This two-dimensional limitation is fully admitted by the Examiner (see Office Action, page 8, second paragraph). Thus the Examiner's contention that Crane teaches abutment members is without merit.

In direct contrast, claim 16 recites structure including an intermediate member having a predetermined length that can be extended to accommodate books of different sizes. Claim 16 further recites top and bottom anchors having a thickness in a direction perpendicular to the length of the spine preventing the bookmark from being removed from the book in a direction

parallel to the length of the spine. Even individually, these features are not shown or suggested in Crane.

The Examiner also relies on U.S. Patent No. 3,898,951 to Clare. This patent discloses a bookmark comprising an elongated stretchable member having a closed loop at one end for encircling a cover of the book. Thus the bookmark is secured to the book. The remaining portion of the stretchable member is inserted at the page to be marked and extends outside the book in such a manner that it can be wrapped onto that portion of the loop exposed on the front cover of the book and releasably secured thereto by a velcro type fastener. The marking portion terminates in a free end and has an ornament extending therefrom. Thus, in contrast to the present invention, the bookmark as taught in Clare is secured directly to the book and the portion inserted between the pages has no stop members to prevent it from being removed from the book.

U.S. Patent No. D280,529 to Cox provides an ornamental design for a book marker having an elongated member with a rounded free end and a comical figure head attached to the opposing end on a multi-layered base. No flexibility is shown in the elongated member and the length of the mark can not be extended to accommodate different book sizes. There would be no need for this feature because this bookmark does not have anything resembling the double ended anchor structure as in the present invention.

A review of these references, and particularly the limited disclosure provide by the two design patents reveals that a bookmark having an intermediate member with a predetermined length that can be extended and including a double ended anchor structure as recited in claim 16 is neither shown nor suggested. The bookmark in Clare is actually secured to the book which the present invention sought to avoid by not providing a clip feature. The present invention is instead merely inserted between pages of the book and is not connected to the book in any manner. The present invention provides an intermediate member with an adjustable length to enable the anchors to abut the respective top and bottom of books of a variety of sizes. This feature is not shown in any of the cited references. Consequently, Applicant believes claim 16 distinguishes over the prior art and is in condition for allowance.

Claim 17 depends from claim 16 and recites the intermediate member as being formed of an elastomeric material.

Claims 18-21 include all the limitations of claim 16 and further recite the character having features of an animal, cartoon character, human, or humanoid.

Claim 22 depends from claim 16 and brings out the feature of the top anchor including an upper torso supporting a head and a set of upper limbs and the bottom anchor including a lower torso attached to a pair of lower limbs.

Claim 23 depends from claim 22 and brings out the feature of the lower limbs being constructed to retain a coiled portion of the intermediate member. This feature is not shown nor suggested in any of the cited references.

Claim 24 depends from claim 16 and recites the anchors as being made of a plush material.

Claim 25 includes all the limitations of claim 16 and recites first and second fastener elements for releasably engaging the top and bottom anchors. This structural recitation is not shown in the cited references.

Claims 26-27 are dependent on claim 25 and recites the fasteners as being comprised of the snap or hook and loop variety.

Claim 28 depends from claim 16 and brings out the feature wherein the bookmark may be coiled to bring the top and bottom anchors together to assume a storage position in the form of the sitting character. This feature is not described in the references.

Claim 29 includes all the limitations of claim 16 and recites both anchors being three-dimensional.

Independent claim 30 is directed to a bookmark and recites:

30. (New) A bookmark for insertion between the pages of a book including a spine and comprising:

a thin, flexible, elongated, stretchable connector having a first end and an opposing second end, said connector having a predetermined width;

a three-dimensional, top stop in the form of a figure having an upper torso supporting a head and a pair of forelimbs; and

a three-dimensional, bottom stop in the form of a complementary portion of said top stop and including a retention member for retaining a coiled portion of said connector; and

wherein said stops inhibit the removal of the bookmark in a direction substantially parallel to the length of the spine when the bookmark is inserted between pages of the book.

The recited combination of a stretchable connector having three-dimensional opposing complementary stops is nowhere shown nor suggested in any of the references. Applicant wishes to respectfully remind the Examiner that “[t]o establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion, or motivation in the prior art to make the specific combination that was made by the applicant.” *In Re Dance*, 48 U.S.P.Q.2d 1635, 1637 (Fed.Cir. 1998). As discussed above, the references relied upon by the Examiner do not provide such a motivation to produce the structure

recited in either claim 16 or claim 30 and therefore a prima facie case for obviousness can not be established.

Claim 31 depends from claim 30 and brings out the feature of the stops cooperating to form a sitting figure when the connector is coiled around the bottom stop. This feature is not shown nor suggested in any of the references of record.

CONCLUSION

From the foregoing amendments and remarks, Applicant earnestly believe the claims are in condition for allowance and respectfully request that the application be passed to issue. An early indication of allowance is respectfully solicited.

Enclosed is our check for \$435.00 for a three month extension of time for a small entity. If any additional fees are required, please charge our Deposit Account No. 21-0800.

Respectfully submitted,

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